

REMARKS

Claim Amendments

Claims 38-40, 54, 63, 66 and 67 have been amended. Claims 55, 57, 61, 62, 64 and 65 have been canceled pursuant to the amendments. Applicants reserve the right to pursue claims to subject matter canceled from claims in a continuation application.

Claims 38-40 have been amended to recite that the protease inhibitors are di-, tri- or tetra-peptidyl boronate or di-, tri- or tetra-peptidomimetic boronate protease inhibitors, where the boronate moiety replaces the C-terminal carboxylate moiety. Support for the amendment can be found at page 8, lines 9-17, page 9, line 7 through page 11, line 19 and page 12, line 7 through page 13, line 10.

Claims 54, 63, 66 and 67 have been amended in accordance with the amendments to claims 38-40.

No new matter has been added.

Rejection of Claim 42 Under 35 U.S.C. § 112, First Paragraph

Claim 42 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 42 has been canceled, thereby obviating the rejection. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 38-42 and 46-68 Under Obviousness-Type Double Patenting

Claims 38-41 and 46-68 are provisionally rejected under obviousness-type double patenting over U.S. Application Nos. 09/601,432, 10/190,267 and 10/794,316 and claims 38-42 and 46-68 are rejected under obviousness-type double patenting over U.S. Patent No. 6,803,357.

Applicants request that the Examiner hold these rejections in abeyance until allowable subject matter is identified in the instant application.

Rejection of Claims 38-40, 46-53 and 68 Under 35 U.S.C. § 102(e)

Claims 38-40, 46-53 and 68 are rejected under 35 U.S.C. § 102(e) as being anticipated by Villhauer (US 6,011,155).

The present claims are directed to methods where di-, tri- or tetra-peptidyl boronate or di-, tri- or tetra-peptidomimetic boronate protease inhibitors, where the boronate moiety replaces the C-terminal carboxylate moiety, are administered. Villhauer does not teach such protease inhibitors. Thus, Villhauer does not teach every element of the claims and therefore does not anticipate any instant claim. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 38-40, 46-53 and 68 Under 35 U.S.C. § 103(a)

Claims 38-40, 46-53 and 68 are rejected under 35 U.S.C. § 103(a), as being obvious over DE 196 16 486 (hereinafter "the '486 Patent").

The present claims are directed to methods where di-, tri- or tetra-peptidyl boronate or di-, tri- or tetra-peptidomimetic boronate protease inhibitors, where the boronate moiety replaces the C-terminal carboxylate moiety, are administered. The '486 Patent does not teach or otherwise suggest methods where such protease inhibitors are administered. Because the '486 Patent does not teach or otherwise suggest the use of the recited protease inhibitors, one of ordinary skill in the art would not have been motivated to practice the instantly-claimed methods. Thus, the instant claims are not obvious over the '486 Patent. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response, aside from the fee associated with the Petition for Extension of Time and Request for Continued Examination. However, if an

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additional fee is due, please charge our Deposit Account No. 18-1945, from which the undersigned is authorized to draw, under Order No. TUU-P01-006.

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Respectfully submitted,

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